



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/978,539	10/18/2001	Yushi Niwa	017661-0180	5077

22428 7590 12/02/2004

FOLEY AND LARDNER
SUITE 500
3000 K STREET NW
WASHINGTON, DC 20007

EXAMINER

JASMIN, LYNDIA C

ART UNIT	PAPER NUMBER
----------	--------------

3627

DATE MAILED: 12/02/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/978,539

Applicant(s)

NIWA, YUSHI

Examiner

Lynda Jasmin

Art Unit

3627

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 18 October 2001.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-18 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-18 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 02 May 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 7.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

1. Preliminary amendment filed October 18, 2001 has been acknowledged.

Claim Objections

2. Claims 17 and 18 objected to because of the following informalities: claims 17 and 18 depending from claim 16 are the same. Thus claim 18 is objected to since it does not further limit the claimed invention. Appropriate correction is required.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claims 1-18 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The claims are replete with errors, a few examples follows:

Regarding claims 1-12, the word "means" is preceded by the word(s) "release, distribution, judgment, accounting and regulation" in an attempt to use a "means" clause to recite a claim element as a means for performing a specified function. However, since no function is specified by the word(s) preceding "means," it is impossible to

Art Unit: 3627

determine the equivalents of the element, as required by 35 U.S.C. 112, sixth paragraph. See *Ex parte Klumb*, 159 USPQ 694 (Bd. App. 1967).

Claims 1-16 are replete with lack of antecedent basis. For example, in claim 1, the recitations "the remaining undistributed part" (I10); "the attribute data reproducible" (I11); "the time of the decision at the earliest" (I12); "the receipt of a request" (I14).

Same remarks are in the remaining claims 2-4.

In claims 3, 4, the recitation "and/or" is indefinite.

In claims 5 and 10-12, the recitation "according to the progress of the reproduction" lacks proper antecedent basis.

In claim 7, the recitation "the amount of money to be paid from the user's balance" lacks proper antecedent basis.

In claim 8, the recitation "the completion of accounting" lacks proper antecedent basis.

In claim 9, the recitations "the period of validity", "the time of no sharing", "the time of no charging" "the equivalent value", "the issued sales code" lack proper antecedent basis.

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

8. As best understood, claims 1-18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ebisawa (20020129349 A1), in view of Downs et al. (6,226,618).

Ebisawa discloses the data distribution as claimed having partial data preliminary distribution means for distributing partial data (via sending part of a game software), comprising a part of distribution data for which time of start of use has been fixed, together with attribute data, which can be disclosed before the arrival of the time of start of use including the time of start of use of the distribution data, before the arrival of time of the start of use to a storage region provided in each user side (§s 0034-0036), and partial data reproduction release which, when the user side has decided to purchase the partial data distributed by the partial data preliminary distribution means or the remaining undistributed part of the distribution data, renders the partial data except for the attribute data reproducible from the time of the start of use at the earliest (§s 0133-0136). Ebisawa further discloses that the distribution data are distributed through a radio network (via communication network or the like).

Ebisawa however fails to explicitly disclose attribute data, based on price of the data and payment judgment upon the receipt of a request.

Downs discloses the concept of delivering electronic content where deployment of an electronic distribution system provides the Digital Content Providers the ability to achieve fast settlement of payment through immediate sales reporting and electronic reconciliation as well as gain secondary sources of revenue through redistribution of content. Downs further discloses a payment ability judgment via a Clearinghouse that keeps a record of all transactions where a key exchange is cleared through the Clearinghouse. This record allows for the metering of licensing authorization. The transaction record can be reported to responsible parties, such as, content proprietors or Content Provider(s), retailers, and others, on an immediate or periodic basis to facilitate electronic reconciliation of transaction payments and other uses. The distribution of data supports both point-to-point such as the Internet and broadcast distribution models such as broadcast television. The clearinghouse further maintains account balance in a billing subsystem and generates Reports using the information that are logged during End-User(s) purchase transactions.

From this teaching of Downs, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the digital data distribution of Ebisawa to include the monitoring of usage and charges of Downs in order to facilitate management of user's accounts.

Art Unit: 3627


Conclusion

9. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Ellis et al. discloses and interactive program guide that provide users with the ability to select programs for recording. Peterka et al. discloses multicasting system where user views a portion of program and decides whether to order the content. Lisanke et al. discloses a method, which allows recording with permission.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Lynda Jasmin whose telephone number is (703) 305-0465. The examiner can normally be reached on Monday- Friday (8:00-5:30) alternate Fridays off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Robert P Olszewski can be reached on (703) 308-5183. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Lynda Jasmin
Primary Examiner
Art Unit 3627
11/29/04